

In re Application of:
Cope et al.
Application No.: 10/047,253
Filed: January 14, 2002
Page 8

PATENT
Attorney Docket No.: CIT1510-4

REMARKS

Claims 32, 33 and 78 have been amended. Claims 1-31, 34-35, 38-40, 58-73, 76 were previously canceled without prejudice or disclaimer. Subsequent to the entry of the present amendment, claims 32-33, 36-37, 41-57, 74-75 and 77-78 are pending and at issue. These amendments and additions add no new matter as the amendments are fully supported by the specification and original claims.

The following is a response to the Final Office Action mailed August 24, 2006.

I. Amendment of the Specification and Claims

The paragraphs following the "Brief Description of the Drawings" have been amended to include sequence identification numbers. No new matter has been added, as the sequence identification numbers are found in the Sequence Listing. Filed June 8, 2006.

Claims 32 and 78 have been amended to improve their form and, in part, per the suggestion of the Examiner in an e-mail correspondence to Lisa Haile, J.D. Ph.D., dated February 22, 2007.

Claim 33 has also been amended to improve its form.

No new matter has been added.

II. Rejections under 35 U.S.C. § 112, Second Paragraph

The following claims have are being rejected under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse these rejections as they apply to the pending claims as provided below.

In re Application of:
Cope et al.
Application No.: 10/047,253
Filed: January 14, 2002
Page 9

PATENT
Attorney Docket No.: CIT1510-4

A. Rejection of claims 32-33 and 78

According to the Office Action (page 3), claims 32-33 and 78 recite the phrase "as set forth in". The metes and bounds of the phrase in the context of the claims are not clear. The Examiner suggests amending the phrase as "the Rpn11 polypeptide comprising the amino acid sequence of SEQ ID NO:23 or 24".

Claims 32, 33 and 78 have been amended as discussed above and, in part, per the suggestion of the Examiner in the e-mail correspondence above to Lisa Haile, J.D. Ph.D, to recite a method of identifying an agent that affects isopeptidase activity of an Rpn11 polypeptide "having the amino acid sequence of SEQ ID NO:23 or 24". Thus, the claims are clear and definite.

Accordingly, withdrawal of rejection of claims 32-33 and 78, and dependent claims therefrom, under 35 U.S.C. §112, second paragraph is respectfully requested.

B. Rejection of claim 32 and 78

According to the Office Action (page 4), claims 32 and 78 are indefinite for reciting the phrase "determining the isopeptidase activity of the test agent by measuring deconjugation of the modifier protein from the target protein". The metes and bounds of the phrase in the context of the above claims are not clear to the Examiner.

Claims 32 and 78 have been amended as discussed above and, in part, per the suggestion of the Examiner in the e-mail correspondence above to Lisa Haile, J.D. Ph.D., to recite a method of identifying a test agent which affects isopeptidase activity of an Rpn11 polypeptide. Determining the isopeptidase activity of Rpn11 is performed by "measuring deconjugation of the modifier protein from the target protein in the presence and absence of the test agent, wherein a difference in the isopeptidase activity in the presence versus the absence of the test agent is indicative of an agent that affects isopeptidase activity of the Rpn11 [AMSH] polypeptide". Thus, the claimed methods are clear and definite.

In re Application of:
Cope et al.
Application No.: 10/047,253
Filed: January 14, 2002
Page 10

PATENT
Attorney Docket No.: CIT1510-4

Accordingly, withdrawal of rejection of claim 32 and 78 under 35 U.S.C. §112, second paragraph is respectfully requested.

C. Rejection of claim 33

According to the Office Action (page 6), claim 33 is indefinite for reciting the phrase “an amino acid sequence as set forth in SEQ ID NO:2”. The metes and bounds of the phrase in the context of the above claims are not clear to the Examiner.

Claim 33 has been amended to recite “the amino sequence of SEQ ID NO. 2”. Hence, the claimed methods are clear and definite.

Accordingly, withdrawal of rejection of claim 33 under 35 U.S.C. §112, second paragraph is respectfully requested.

In re Application of:
Cope et al.
Application No.: 10/047,253
Filed: January 14, 2002
Page 11

PATENT
Attorney Docket No.: CIT1510-4

CONCLUSION

In view of the amendments and above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application.

A check in the total amount of \$905.00 is enclosed as payment for the Request for Continued Application fee (\$395.00) and three-month Extension of Time fee (\$510.00) for small entity. No other fees are deemed necessary with the filing of this paper. However if any fees are due, the Commissioner is hereby authorized to charge any fees, or make any credits, to Deposit Account No. 07-1896 referencing the above-identified attorney docket number. A copy of the Transmittal Sheet is enclosed.

Respectfully submitted,



Lisa A. Haile, J.D., Ph.D.
Registration No. 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

DLA PIPER US LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133
USPTO Customer No. 28213